

REMARKS

Claims 1-18 are pending. By this Response, Applicant amends claims 6, 12, and 18, and adds new claims 19 and 20. Support for new claims 19 and 20 may be found, for example, in paragraph [72] of the originally filed specification. The amendments to claims 6, 12 and 18 replaced the Trademark “ZIP code” with “destination code.” Accordingly, claim 1-20 are before the Office for examination on the merits.

In the Office Action,¹ the Examiner rejected claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,148,291 (“Radican”) in view of U.S. Patent No. 5,216,620 (“Sansone”). Claims 1, 7 and 13 are independent. Applicant respectfully traverses the § 103(a) rejection based on Radican in view of Sansone for at least the reasons outlined in more detail herein.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” Id. at § 2143.01(III) (emphasis in original). “All words in a claim must be considered in judging the patentability of that claim against the prior

¹ Applicant respectfully submits that the Office Action contains a number of assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicant respectfully declines to automatically subscribe to them.

art.” Id. at § 2143.03. “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” Id. at § 2141.02(I).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” Id. at § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” Id. at § 2141(III).

Here, a *prima facie* case for obviousness has not been established at least because the scope and content of Sansone has not been properly determined, and consequently, the Office Action does not recognize the large differences between Applicant’s claims and the prior art. Accordingly, irrespective of the teachings of the primary reference Radican, Applicants respectfully request the reconsideration and withdrawal of the rejections based on Radican in view of Sansone for at least the reasons outlined below.

In the Office Action, the Examiner alleged that Sansone teaches “a generated enhanced label, the enhanced label comprising a routing code and a label unique identifier,” Office Action, 3 (internal citation omitted). Applicant disagrees.

Instead, Sansone describes a label 29, depicted in Fig. 2a, reproduced below, lack a label unique identifier. “With reference to FIG. 2a, the label **29** includes

information identifying the mailer **50** and his location including his first three zip code digits, the destination of the tray **52** and the zip code thereof **54**, the airport **56** to which the tray is to be sent, and the tray contents **58** including the class of mail, zip code information and degree of sortation." Sansone, col. 4, ll. 21-27.

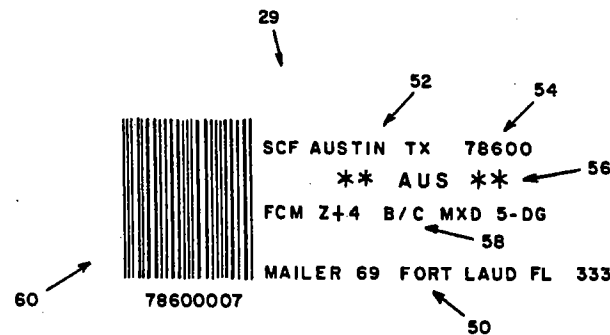


FIG 2A

Sansone further discloses a tag 32, depicted in Fig. 2b, reproduced below, used to provide verification information and to identify the distribution center "having the destination **50** of the tray, the first three digits of the zip code **52**, the class of mail **54**, **56** and the identification number **57** of the contract between the post office **14** and the common carrier **38** at the lower portion thereof. At the lower portion is shown the dock number **59** where the tray is to be routed, the airline and flight number **58**, the routing information **60**, time of departure **62**, expected time of arrival **64**, and the weight in pounds of the individual tray and total weight of all trays **66** on the particular flight." Id. at col. 4, ll. 30-40.

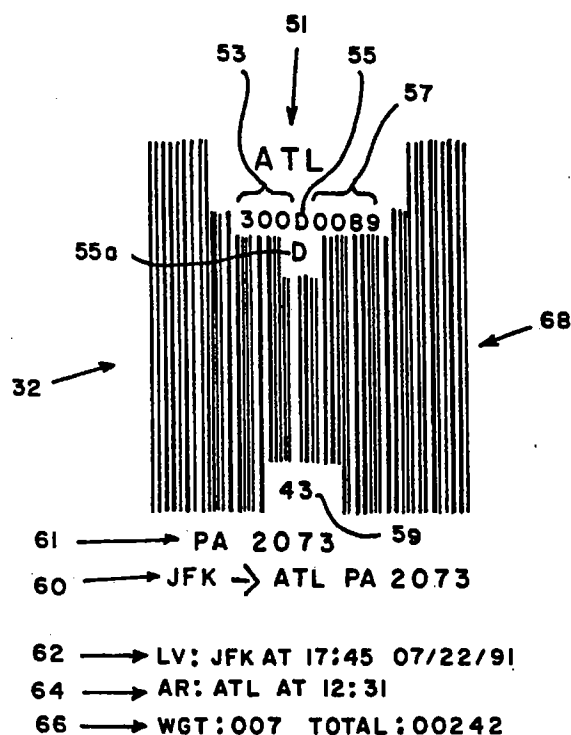


FIG. 2B

Applicant respectfully submits that the information provided on Sansone's label 29 and tag 32 fails to correspond to an enhanced label as recited in independent claims 1, 7 and 13. Applicant respectfully submits that the Examiner's assertion indicates an apparent misinterpretation of Sansone and/or the claims of the present application. The notion that label 29 or tag 32 discloses an enhanced label is inaccurate because none of the information provided on label 29 or tag 32 corresponds to a label unique identifier, which is included in the enhanced label of claims 1, 7, and 13.

Instead, as described above, Sansone's label 29 and tag 32 recite different types of information, none of which result in at least a unique label identifier. Those types of information are representative of typical characteristics—destination, origination,

physical properties, the mailer, and the like—of the tray, none of which serve to uniquely distinguish the tray, hence the label, from other trays and labels. Applicant respectfully submits that the information displayed on either of label 29 or tag 32 is the type of information that can be found on any other tray matching those characteristics. For instance, multiple trays in the same container may share all of the characteristics identified in label 29 or tag 32.

Accordingly, Sansone does not disclose the enhanced label recited in each of independent claims 1, 7, and 13. Without that enhanced label, Sansone's label 29 or tag 32 could not be used to track individual mail trays. Accordingly, if a mail tray is misrouted or lost, there is no way to easily find the location of the tray. Given that the claimed enhanced label is used to track a tray of items, Sansone's failure to disclose a label unique identifier is a significant difference between Applicant's claims and the prior art, among other differences.

For at least the foregoing reasons, the scope and content of Sansone and the differences between the claimed inventions and the cited references have been improperly determined, and a *prima facie* case for obviousness has not been established for independent claims 1, 7, and 13. Moreover, Applicant respectfully points out that Radican fails to rectify the deficient teachings of Sansone and respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection of those claims.

For at least the above-outlined reasons, Applicant's independent claims 1, 7, and 13 should be allowable. Claims 2-6, 8-12 and 14-20 depend from a corresponding one of the allowable independent claims. Therefore, those dependent claim should be

allowable for at least the same reasons the corresponding independent claims are allowable, as well as by virtue of reciting additional elements not taught nor suggested by the cited references.

Applicant respectfully requests the reconsideration of the application, withdrawal of the claim rejections, and timely allowance of pending claims 1-20.

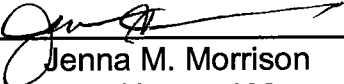
If the Examiner believes that a conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicant's undersigned attorney at (404) 653-6400.

Please grant any extensions of time required to enter this Response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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Dated: May 6, 2009

By: 
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